

REMARKS

Claims 20-28 and 32-39 are pending in this application. By this Amendment, claim 20 has been amended and claims 29-31 have been canceled. Claim 20 is independent. Reconsideration of the application is respectfully requested.

Entry of the amendments is proper under 37 CFR §1.116 because the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issue requiring further search and/or consideration as the amendments amplify issues previously discussed throughout prosecution; and (c) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection. Entry of the amendments is thus respectfully requested.

I. Amendment

The subject matter of dependent claim 31 and intervening claim 29 has been incorporated into independent claim 20. No new matter is added.

II. Rejection Under 35 U.S.C. §112, First Paragraph

The Office Action rejects claims 20-39 under 35 U.S.C. §112, first paragraph. Claim 20 has been amended to obviate the rejection. Accordingly, withdrawal of the rejection is respectfully requested.

III. The Claims Define Patentable Subject Matter

The Office Action rejects claims 20-39 under 35 U.S.C. §103(a) over U.S. Patent No. 5,749,970 to Fukuta et al. (Fukuta) in view of U.S. Patent No. 4,728,539 to Gane. This rejection is respectfully traversed.

Independent claim 20 recites, *inter alia*, "the sheet-like elastic body has a thickness of 1-5 mm and a width of 1-10 mm." The applied references fail to teach or render obvious the recited features of independent claim 20.

The Office Action admits that the references do not disclose the above-quoted feature. The Office Action asserts that the recited thickness and width of the flexible blade would have been determined through routine experimentation in the absence of a showing of criticality. This assertion is improper.

The above-quoted feature is "critical," as described in the present application. Based on the examples of Table 1 in the specification, when the width of the elastic body is greater than 10 mm, peeling of the outer peripheral surface and partial uncoating is significantly higher (i.e., more than 10% and less than 20% of the outer peripheral surface). See page 31, line 17 - page 32, line 17 and Examples 6 and 7 of the specification. Also, when the thickness of the elastic body is greater than 5, the total area of the partial uncoating portion and the peeling portion is significantly higher (i.e., more than 10% and less than 20% of the outer peripheral surface). See Examples 10 and 11 of Table 1. Also, when the thickness of the elastic body is between 1 and 5 and the width of the elastic body is between 1 and 10, the total area of the partial uncoating portion and the peeling portion is low (i.e., 10% or less of the outer peripheral surface). See Examples 1-5, 8, 9 and 12-14 of Table 1. Thus, the thickness and width of the elastic body are critical factors. The applied references do not recognize the criticality of the thickness and width of the elastic body, so criticality of the thickness and width of the elastic body rebut that the claimed thickness and width of the elastic body is obvious.

Furthermore, section 2144.05 II.B. of the MPEP recites "[a] particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation." Under the result effective variable doctrine, the thickness and width of the elastic body must first achieve a recognized result before it can even be asserted that optimization can occur through routine experimentation. None of the

applied references recognize that thickness and width of the elastic body affects the total area of the partial uncoating portion and the peeling portion.

Accordingly, the applied references do not recognize that the thickness and width of the elastic body is a result-effective variable and they also do not recognize the criticality of the thickness and the width of the elastic body. Thus, the applied references, alone or in combination, fail to teach or render obvious that the sheet-like elastic body has a thickness of 1-5 mm and a width of 1-10 mm.

The dependent claims are patentable at least due to their dependence on allowable independent claim 20 and for the additional features that they recite.

Accordingly, withdrawal of the rejection of the claims is respectfully requested.

IV. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 20-28 and 32-39 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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